

**REMARKS**

Please reconsider the application in view of the above amendments and the following remarks. Applicants thank the Examiner for carefully considering this application.

**Disposition of Claims**

Claims 1-12 were pending in this application. By way of this reply, claims 13-18 have been added. Thus, claims 1-18 are now pending in the present application. Claims 1, 11 and 13 are independent. The remaining claims depend, directly or indirectly, from claims 1, 11, and 13.

**Claim Amendments**

New claims 13-18 have been added by this reply. Support for the new claims may be found, for example, in the originally-filed claims of U.S. Application Serial No. 10/528,249 (“Specification”). No new matter has been added by any of the aforementioned amendments.

**Rejections Under 35 U.S.C. § 102(e)**

Claims 1-3, 5, 7, and 11-12 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,576,991 (“Bonvalot”)<sup>1</sup>. For the reasons set forth below, the rejection is respectfully traversed.

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<sup>1</sup> Applicants note that the Examiner included the incorrect patent number in the body of the Action

Specifically, independent claim 1 requires, in part,

"...a cover-wafer-depositing step, in which a cover wafer is deposited on the active face so as to obtain a wafer assembly, the cover wafer being provided with plurality of chip-receiving cavities, a chip-receiving cavity being located above a chip element..." (emphasis added) .

The aforementioned limitations explicitly require a plurality of chip-receiving cavities, such that a chip-receiving cavity is located above a chip element. Independent claim 11 includes similar limitations to those included in independent claim 1.

Turning to the rejection, "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (emphasis added). Further, "[t]he identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Applicants assert that Bonvalot fails to disclose all the limitations of independent claims 1 and 11.

Specifically, the Examiner points to Figure 1, openings (8) of Bonvalot as illustrating chip-receiving cavities. *See* Action, p. 3. Applicants assert, however, that Bonvalot's openings cannot be equated to the claimed chip-receiving cavities. In particular, the openings depicted in Figure 1 of Bonvalot merely function as a "passage way," *i.e.*, wires are able to electrically connect to an electric device, *e.g.*, chip, outside the cavity. The electric device, however, is never disclosed as disposed in the opening, nor is the opening disclosed as configured to receive a chip. Said another way, an opening that is not described as able to receive a chip or hold a chip, cannot be a chip-receiving cavity. Thus, Bonvalot is completely silent with respect to a chip-receiving cavity as required by independent claims 1 and 11.

Further, assuming *arguendo* that the opening is a chip-receiving cavity, Applicants assert that Bonvalot is also completely silent with respect to a chip-receiving cavity located above a chip element. In the Action, on page 3, the Examiner cites Bonvalot (Figure 1) as disclosing the aforementioned limitation. Applicants, however, respectfully disagree. Specifically, the description of Figure 1 discloses that electric devices are configured to connect to the free ends of wires (9). Not only does Figure 1 fail to show these electric devices, the way the wires (9) are positioned, *i.e.*, upwards, indicates that electric devices would not be positioned below the opening. Said another way, a chip element is not located below an opening of Bonvalot, and thus, Bonvalot is completely silent with respect to this limitation.

Moreover, independent claim 11 also requires “a chip fixed in the cavity.” As discussed above, Bonvalot fails to disclose a chip fixed in the cavity, but instead, acts as a passageway for wires between, *e.g.*, contact pads and electric devices. Thus, Bonvalot is also completely silent with respect to a chip fixed in the cavity as required by independent claim 11.

In view of the above, independent claims 1 and 11 are patentable over Bonvalot. Dependent claims are patentable over Bonvalot for at least the same reasons as the aforementioned independent claims. Accordingly, withdrawal of this rejection is respectfully requested.

### **Rejections Under 35 U.S.C. § 103**

Claims 4 and 6-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bonvalot. Claims 4 and 6-10 depend from independent claim 1. For the reasons set forth below, the rejection is respectfully traversed.

Applicants respectfully assert that the use of Bonvalot to reject claims 4 and 6-10 under 103(a) is improper under 35 U.S.C. § 103(c). Subject matter developed by another person, which qualifies as prior art only under one or more of 35 U.S.C. § 102 (e), (f), and (g) does not preclude patentability under 35 U.S.C. § 103 “if the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” *See* 35 U.S.C. § 103(c).

Bonvalot, which filed as a PCT application prior to November 29, 2000, completed the requirements of 35 U.S.C. §371(c)(1), (2), and (4) on January 28, 2002 (*i.e.*, the effective 35 U.S.C. § 102(e) date), and Applicants priority filing date is September 24, 2002, thus making Bonvalot prior art under 35 U.S.C. § 102(e). Further, the Applicants patent application and Bonvalot were, at the time of the Applicants invention, commonly owned. Specifically, Bonvalot is assigned to Axalto SA (formerly Schlumberger Systems)<sup>2</sup>, and Applicants patent application is assigned to Axalto, SA (formerly Schlumberger Systems)<sup>3</sup>. Accordingly, the use of Bonvalot in an obviousness rejection of claims 4 and 6-10 is improper under 35 U.S.C. § 103(c), and withdrawal of this rejection is respectfully requested.

### **New Claims**

As discussed above, new claims 13-18 have been added by way of this reply. Claim 13 is independent. Further, new claims 14-18 depend directly from claims 1, 11, and 13. Claims 13-18 are patentable over Bonvalot for at least the reasons discussed above with respect to independent

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<sup>2</sup> See, Reel 012594/Frame 0500 (assignment from inventors to Schlumberger Systems); Reel 016883/ Frame 0316 (change of name from Schlumberger Systems to Axalto SA).

claims 1 and 11. Accordingly, favorable action in the form of a Notice of Allowance is respectfully requested.

### **Conclusion**

Applicants believe this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/055001).

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Respectfully submitted,

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<sup>3</sup> See, Reel 016517/Frame 0574 (assignment from inventors to Axalto SA).